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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,983	08/23/2001	Kevin Dumstorff	7164	1324

7590 06/26/2003
PAUL M. DENK
763 South New Ballas Rd.
St. Louis, MO 63141

EXAMINER

LUK, EMMANUEL S

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,983

Applicant(s)

DUMSTORFF ET AL.

Examiner

Emmanuel S. Luk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 2, drawn to a method of molding a one-piece key fob, classified in class 264, subclass 219.
 - II. Claims 3 and 4, drawn to an injection molding machine, classified in class 425, subclass 182.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as one that involves injecting a material that includes a polymer and a filler.

3. During a telephone conversation with Paul Denk, by Examiner Monica A. Fontaine, on 28 October 2002, a provisional election was made with traverse to prosecute the invention of Group II, claims 3 and 4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 and 2 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaka.

Tasaka teaches an injection mold having a mold portion defining a mold portion cavity with mold blank recesses (30a; 31a), where mold blanks and mold portion cavities are placed (36, 37, 46, 47) are placed to form a unified molding cavity.

Tasaka fails to teach the cavity to receive melted polymers and adapted to form an extending tab and base portion of the key fob, and cavities of different sizes and shapes.

In regards to the melted polymers, this is an intended use of the apparatus, various materials can be received into the cavities to be shaped, thus it would have been obvious to one of ordinary skill in the art to modify Tasaka to use a variety of materials that can be inserted into the cavities.

In regards to the shape and sizes of the cavities, the interchangeable mold parts of Tasaka allows for different mold parts to be placed and it would have been obvious to one of ordinary skill in the art to have different shapes and sizes of the cavity shapes to be used. It is merely a change in size and shape of the cavity surface for the mold product which is a design choice of the user and does not have a new or unexpected result from the change in shape and size for the apparatus.

9. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrickson et al.

Hendrickson teaches the claimed apparatus having a mold base (14) and can accommodate different mold inserts (36) that would have different cavity features. This allows for different parts production (Col. 5, lines 6-8) and that plastic is formed in the apparatus (Col. 5, lines 11-14). The inserts are the mold blanks that are placed into the recesses provided by the mold base.

Hendrickson fails to teach specifically teach mold blanks and the cavities adapted to form an extending tab and base portion of the key fob, and cavities of different sizes and shapes.

Hendrickson does teach the production of different parts, thus one of ordinary skill in the art understands that different cavity shape and sizes are inferred in Hendrickson.

In regards to the production of key fobs, this is merely a change in shape and sizes of the cavities, the interchangeable mold parts of Hendrickson allows for different mold parts to be placed and it would have been obvious to one of ordinary skill in the art to have different shapes and sizes of the cavity shapes to be used. It is merely a change in size and shape of the cavity surface for the mold product which is a design choice of the user and does not have a new or unexpected result from the change in shape and size for the apparatus.

10. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt et al.

Pratt teaches a mold bases (10) having a mold half (102) and a second mold half (100) that have die insert assemblies that insert into a pocket (118, 120) in the mold halves for placing interchangeable parts (Col. 3, lines 5-12), this allows for a switch in production of different mold items (Col. 1, lines 23-25). The inserts are the mold blanks that are placed into the pockets that are the mold blank recesses.

Pratt et al fails to teach the cavities forming key fob extending tabs and mold base.

The key fob production is a merely a change in shape and sizes of the cavities, the interchangeable mold parts of Tasaka allows for different mold parts to be placed and it would have been obvious to one of ordinary skill in the art to have different shapes and sizes of the cavity shapes to be used. It is merely a change in size and shape of the cavity surface for the mold product which is a design choice of the user and does not have a new or unexpected result from the change in shape and size for the apparatus.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DiSimone et al, Leitch et al and Spiess.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel S. Luk whose telephone number is (703) 305-1558. The examiner can normally be reached on Monday through Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

E.L.
June 17, 2003

Walker
W. L. WALKER
SUPERVISORY PATENT EXAMINER
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